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OFFICE OF PETITIONS

In re Patent, No. 6,056,421 :
Michael Johnson :
Issue Date: May 2, 2000 : ON PETITION
Application No. 08/519,200 :
Filed: August 25, 1995 :
Title: ARCHITECTURAL LIGHTING:
DEVICES WITH PHOTSENSITIVE :
LENS :

This is a decision on the PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED (37 CFR 1.378(b)) filed July 21, 2012.

The patent issued May 2, 2000. The first maintenance fee with late surcharge was timely paid on April 30, 2004. The second maintenance fee with late surcharge was timely paid on May 2, 2008. The grace period for paying the 11-½ year maintenance fee expired at midnight on May 2, 2012, with no payment received. The fee was received in the Office after the expiration of the patent and refunded to patentee by treasury check.

Petitioner argues that the delay in payment of the maintenance fee is unavoidable as: He did pay the patent fee, via certified mail, prior to the expiration date of May 2, 2012. He states that he was informed by the post office clerk that mailing takes 2-3 days for delivery to the Washington DC area. In support thereof, petitioner submits a copy of certified mailing receipts as proof of intent.

The petition includes a \$620 payment. The 11 ½ year maintenance fee is not enclosed. Rather, petitioner states he will not cash (refund) check if petition is allowed.

STATUTES, RULES AND REGULATIONS

35 U.S.C. § 41(c)(1) states that:

The Director may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. §1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The surcharge set forth in §1.20(I)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff 'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff 'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably

prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). However, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

OPINION

The late surcharge for acceptance of an unavoidably delayed payment of the maintenance fee is \$700. The evidence submitted is not sufficient that patentee complied with the requirements of 37 CFR 1.8(b) such that the maintenance fee should be considered timely filed (without payment of a late surcharge). As patentee has only submitted \$700, the petition is dismissed without consideration on the merits as to whether the fee should be considered unavoidably delayed.

Any renewed petition must include the deficiency in payment of the full surcharge of \$700 and payment of the maintenance fee in the amount due as of the date of filing of the renewed petition. Effective October 5, 2012, the 11 ½ year maintenance fee for a small entity will increase to \$2,405.

It is further noted that patentee is not precluded from filing a petition under 37 CFR 1.378(c) based on unintentional delay. Patentee may file such a petition within 24 months of the expiration of the patent. The standard for reinstatement of the patent based on unintentional delay is less stringent.

CONCLUSION

In view thereof, the petition is **DISMISSED**.

Any request for reconsideration of this decision must be filed within TWO MONTHS of the mailing date of this decision. This period is not extendable under § 1.136. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Accordingly, on request for reconsideration, it is extremely important the petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee and the surcharge set forth in § 1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. (Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington DC 20231. A copy of the last decision rendered should accompany the request for refund).

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: Customer Service Window
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Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

/Nancy Johnson/

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